

PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Beer et al.

Group Art Unit:

Serial No. : 10/561,134

Filed : December 15, 2005 Examiner:

Inventor : OPTICAL AMPLIFYING MATERIALS

Date: May 16, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Winston M. Alvarado

**RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER
35 U.S.C. 371 IN THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)**

Examiner Alvarado:

This communication is in response to the above-identified Notice mailed to Applicants on March 16, 2006 (a copy is enclosed herein).

In the Notice the Examiner states that the current translation of the application into English is defective since "the number of claims in the International Application and the number of claims in the translation are not the same". Applicants respectfully disagree and assert an accurate translation was submitted with the filing documents.

The present application is a United States national stage application of PCT application number PCT/EP2004/006711 filed on June 22, 2004 which in turn claims priority of EPO application number 03405471.8 filed June 26, 2003.

Both the PCT application and the priority application were filed in the German language. The English translation of PCT application for filing in the United States was prepared for by Dr. Jakob Kuhn. A Statement by Dr. Kuhn was submitted certifying that he prepared the English translation of the PCT/EP2004/006711 application for filing in the United States and that it was substantially identical to the priority application except that changes that were made were "to correct multiple dependent claims"



(see copy of Dr. Kuhn's Statement).

Applicants acknowledge that the English Translation submitted with the filing contained 15 Claims and that this was to correct multiple dependencies. Applicants herein submit a copy of the exact translation of the PCT Claims (Claims 1-13). It is noted that Claims 9 and 10 of the English translation submitted with the filing are identical to the wording of Claims 6 and 7, with the exception of the claim dependency. These claims contain the identical subject matter of PCT Claims 7 and 8.

Accordingly, Applicants believe they had furnished a proper translation of the application into English at the time of filing and that no surcharge fee is required.

However, in filing a complete response to this action, and if the Examiner finds Applicants arguments and evidence unpersuasive, the English translation surcharge of \$130 may be charged to Deposit Account 50-1541. A duplicate copy of this page is also being submitted.

All filing requirements of this application are believed to be complete. If you have any questions please do not hesitate to contact the undersigned.

Respectfully submitted,
Attorney for Applicants

By: 

Dara L. Onofrio
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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Dated: May 16, 2006


Dara L. Onofrio

Person mailing paper



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

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|-----------------------------|-----------------------|------------------|
| U.S. APPLICATION NUMBER NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 10/561,134 | Robert Beer | ICH 303-US |

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DARA L ONOFRIO
ONOFRIO LAW
107 SHAD ROW
PLERMONT, NY 10968

| | |
|-------------------------------|---------------|
| INTERNATIONAL APPLICATION NO. | |
| PCT/EP04/06711 | |
| I.A. FILING DATE | PRIORITY DATE |
| 06/22/2004 | 06/26/2003 |

COPY

CONFIRMATION NO. 9409
371 FORMALITIES LETTER



OC000000018291460

Date Mailed: 03/16/2006

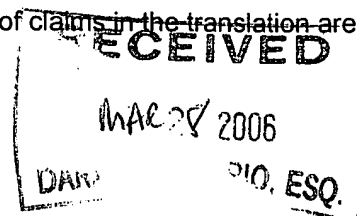
NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 12/15/2005
- Copy of the International Search Report filed on 12/15/2005
- Information Disclosure Statements filed on 12/15/2005
- Oath or Declaration filed on 12/15/2005
- Request for Immediate Examination filed on 12/15/2005
- U.S. Basic National Fees filed on 12/15/2005
- Substitute Specification filed on 12/15/2005
- Priority Documents filed on 12/15/2005
- Power of Attorney filed on 12/15/2005
- Specification filed on 12/15/2005
- Claims filed on 12/15/2005
- Abstracts filed on 12/15/2005

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Translation of the application into English. Note a processing fee will be required if submitted later than 30 months from the priority date.
- Translation of the application into English. The current translation of the application into English is defective as described below. Note a processing fee will be required if submitted later than 30 months from the priority date.
 - The number of claims in the International Application and the number of claims in the translation are not the same.



- Processing fee of \$130 for providing the translation of the application and/or the Annexes later than 30 months from the priority date (37 CFR 1.492(i)).

SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$130** for a Large Entity:

- **\$130** for English translation surcharge required.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

WINSTON M ALVARADO

Telephone: (703) 308-9140 EXT 206

PART 1 - ATTORNEY/APPLICANT COPY

| U.S. APPLICATION NUMBER NO. | INTERNATIONAL APPLICATION NO. | ATTY. DOCKET NO. |
|-----------------------------|-------------------------------|------------------|
| 10/561,134 | PCT/EP04/06711 | ICH 303-US |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Robert BEER; Rolf STEIGER
Michel SCHAR; and Libero ZUPPIROLI

Group Art Unit:

Serial No.: (not yet assigned)

Examiner:

Filed:

For: OPTICAL AMPLIFYING MATERIALS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

COPY
COPY

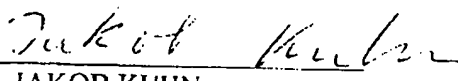
STATEMENT BY DR. JAKOB KUHN

Sir/Madame:

I, Jakob Kuhn, am responsible for patent related matters for ILFORD Imaging Switzerland GmbH, the assignee of the above-identified application. The application is a national stage application of PCT/EP2004/006711 which was filed June 22, 2004 and published as WO 2005/002287 on January 6, 2005 in the German language, which claims priority to European Patent Application 03405471.8 filed June 26, 2003 ("the priority application") which was filed in the German language.

I prepared the English translation of the PCT/EP2004/006711 application for filing in the United States and I certify that the subject matter of the PCT/EP2004/006711 application is substantially identical to that of the priority application. The only changes that were made were to correct multiple dependent claims; to correct bibliographic errors in article citations; and an addition at paragraph [0032] of the specification as to how specific surfaces of the nanocrystalline, nanoporous aluminum oxides and aluminum oxide/hydroxides are determined by the BET isotherm method. Therefore, the present U.S. application as filed in the USPTO is an accurate translation of the PCT and EP priority applications.

Date: November 24, 2005


JAKOB KUHN

Title: PATENT MANAGER, ILFORD Imaging CH GmbH